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BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER	
			SALTARELLI, DOMINIC D.	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	09/875,707	KIKINIS ET AL.
	Examiner DOMINIC D. SALTARELLI	Art Unit 2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

1) Responsive to communication(s) filed on 16 October 2008.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 9-42 is/are pending in the application.

4a) Of the above claim(s) 35-42 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 9-34 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 9-28 have been considered but are moot in view of the new grounds of rejection.

Election/Restrictions

2. Newly submitted claims 35-42 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally claimed invention (claims 9-34) and the invention disclosed in claims 35-42 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because deciding to transmit the alert to a second display does not necessarily need to be contingent upon a determination that the alert is not to be transmitted to a first display, the claimed invention is fully functional in transmitting the alert to the second display regardless of whether the alert is transmitted to the first display or not. The subcombination has separate utility such as a specialized, stand alone interactive device. Such devices are known in the art, having no capability for displaying programming guides or making program selections, and serve only as specialized devices for interacting with particular programs, usually for promotional or game related

Art Unit: 2421

purposes, such as interacting with a commercial to assist in the sale of a product or allowing user interaction with a game show or educational program.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 35-42 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Paragraph 0050 of the specification discloses that 'tangible machine readable media' includes propagated signals, such as optical and acoustical signals, and signals do not fall under any of the statutory classes of 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-11, 13-15, 17-19, 21-23, 25, 28-30, 31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton et al. (5,831,664, of record) [Wharton] in view of Darbee et al. (6,130,726, of record) [Darbee], Goldstein (5,410,326, of record), and Lappington et al. (5,519,433) [Lappington].

Regarding claims 9, 15, 17, 23, 31, and 34, Wharton discloses an entertainment system (figs. 1 and 2) comprising:

a unit configured to transmit information and to receive information via a wireless connection (figs. 1 and 2, set top box 16); and

a plurality of hand held devices configured to simultaneously communicate with said unit (PDAs 12 shown in fig. 2), wherein each hand-held device of the plurality of hand-held devices comprises a control unit configured to interact with an application (col. 1 line 60 – col. 2 line 10 and col. 3 line 25 – col. 4 line 36), wherein selective programming of first hand-held device of the plurality of hand-held devices is communicated to the other hand held devices (col. 4, lines 15-30).

Wharton fails to disclose the unit is configured to receive a signal from a service provider indicating the beginning of an interactive application, the hand held devices interact with an electronic program guide (EPG) and an indicator is displayed separate from the EPG, configured to indicate availability of the interactive application in a program corresponding to the EPG in response to receiving the signal from the unit without providing an indication of the availability of the interactive application on a display configured to display the program

corresponding to the EPG, the display being separate from the plurality of hand-held devices.

In an analogous art, Darbee teaches it was well known to use handheld devices to conveniently view program guide information (col. 6, lines 50-61 and col. 7 line 66 - col. 8 line 26), for the benefit of displaying program guide information without interrupting the display of programming on a television (col. 1, lines 29-39 and col. 2, lines 45-50).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Wharton to use the handheld devices to view an EPG without displaying the EPG on the television, as taught by Darbee, for the benefit of displaying program guide information without interrupting the display of programming on a television, such as a situation where only one individual in a room with several others wishes to view program guide information.

Wharton and Darbee fail to disclose the unit is configured to receive a signal from a service provider indicating the beginning of an interactive application and displaying the indicator, separate from the EPG, to indicate availability of an interactive application in a program corresponding to the EPG, in response to receiving the signal from the unit without providing an indication of the availability of the interactive application on a display configured to display the program corresponding to the EPG, the display being separate from the plurality of hand-held devices.

In an analogous art, Goldstein teaches a set top unit receiving signal a from a service provider indicating the beginning of an interactive function and displaying the indicator, separate from an EPG, to indicate availability of an interactive function in a program corresponding to the EPG, in response to receiving the signal from the unit (col. 22, lines 13-30 and col. 22 line 63 - col. 23 line 2, wherein the function is an interactive function, col. 23, lines 24-29), without providing an indication of the availability of the interactive function on a display configured to display the program corresponding to the EPG, the display being separate from any hand-held devices (the indicator could simply be a sound generated to alert a user, col. 14, lines 3-20), one benefit of which is enabling a viewer to order products advertised in a program at the time of viewing, stimulating impulse purchases which benefit advertisers (col. 7 line 67 - col. line 6 and col. 28 line 59 - col. 29 line 2).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system of Wharton and Darbee to include the unit is configured to receive a signal from a service provider indicating the beginning of an interactive function and displaying the indicator, separate from the EPG, to indicate availability of an interactive function in a program corresponding to the EPG, in response to receiving the signal from the unit without providing an indication of the availability of the interactive function on a display configured to display the program corresponding to the EPG, the display being separate from the plurality of hand-held devices, as taught by Goldstein, for the benefit of

enabling a viewer to order products advertised in a program at the time of viewing, stimulating impulse purchases which benefit advertisers.

Wharton, Darbee, and Goldstein fail to disclose the interactive function is itself an interactive application.

In an analogous art, Lappington teaches providing entire interactive applications to hand held devices that correspond to a particular broadcast program, such as shopping and interactive games that correspond to a particular program (col. 1 lines 36-67).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system of Wharton, Darbee, and Goldstein to include the interactive function is itself an interactive application, as taught by Lappington, for the benefit of increased interactive incentives, such as on the spot ordering and games (Lappington, col. 2, lines 48-62).

Regarding claims 10 and 18, Wharton, Darbee, Goldstein, and Lappington disclose the system of claims 9 and 17, wherein the indicator is displayed on a display of the first hand-held device (Goldstein teaches the indicator could also be a visual indicator, col. 14, lines 3-8, which is shown on hand held devices when the indicator is designated for display on the remote control, col. 23, lines 9-10).

Regarding claims 11 and 19, Wharton, Darbee, Goldstein, and Lappington disclose the system of claims 10 and 18, but fail to disclose the display of the first hand-held device changes background colors (flashes) or generates a sound to indicate the availability of the interactive function in the program corresponding to the EPG.

It is notoriously well known in the art to change the colors of a displayed background in order to draw a viewer's attention to an object or occurrence of interest.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Wharton, Darbee, Goldstein, and Lappington to include the display changes background colors to indicate the availability of the interactive function in the program corresponding to the EPG, as these is a conventional method used draw a viewer's attention.

Regarding claims 13 and 21, Wharton, Darbee, Goldstein, and Lappington disclose the system of claims 9 and 17, wherein the first hand-held device is a personal digital assistant (Wharton, fig. 1, PDA 12).

Regarding claims 14 and 22, Wharton, Darbee, Goldstein, and Lappington disclose the system of claims 9 and 17, wherein the first hand-held device is a web phone (Wharton teaches the PDA is an Apple Newton, col. 3, lines 26-54, a device capable of both telephonic communications and Internet access).

Regarding claim 25, Wharton, Darbee, Goldstein, and Lappington disclose the machine readable medium of claim 17, wherein indicating the availability of the interactive function is performed during display of the program (Goldstein, col. 14, lines 3-20) on a display separate from the plurality of mobile hand-held devices (indicators can also be shown on the display of the TV itself, Goldstein, col. 11, lines 27-31).

Regarding claim 28, Wharton, Darbee, Goldstein, and Lappington disclose the method of claim 9, wherein the signal is received after a start of the selected program (Goldstein, col. 22 line 63 - col. 23 line 8, wherein messages are synchronized with the program, and are thus received during the program itself).

Regarding claims 29 and 30, Wharton, Darbee, Goldstein, and Lappington disclose the method and machine readable medium of claims 9 and 17, wherein the interactive application is not available prior to the beginning of the interactive application (Lappington, col. 1, lines 51-67, where the interactive applications must first be downloaded before they are available).

6. Claims 12, 16, 20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton, Darbee, Goldstein, and Lappington as applied to claims 9,

10, 17, and 18 above, and further in view of Banker et al. (5,477,262, of record)

[Banker].

Regarding claims 12, 16, 20, and 24 Wharton, Darbee, Goldstein, and Lappington disclose system of claims 9, 10, 17, and 18, but fail to disclose a component other than the display (such as a backlit button) of the first hand held device is illuminated to indicate the availability of the interactive function.

In an analogous art, Banker teaches that it was well known to use light emitting diodes which flash in response to receiving a message alert indication as a form of alerting users to the availability of such.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system of Wharton, Darbee, Goldstein, and Lappington to include a component other than the display of the first hand held device is illuminated to indicate the availability of the interactive function, as taught by Banker, as this is only a minor modification to the use of icons on a display device, both serving equally well to notify users, both easily implemented from a technical standpoint, and thus it would have been obvious to simply replace a displayed icon with a flashing LED. This LED could easily be placed within or behind a button on the handheld device.

7. Claims 26, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton, Darbee, Goldstein, and Lappington as applied to claims 25 and 31 above, and further in view of Yen et al. (5,991,799, of record) [Yen].

Regarding claims 26, 32, and 33, Wharton, Darbee, Goldstein, and Lappington disclose the machine readable medium and apparatus of claims 25 and 31, but fail to disclose whether an indication of the availability of the interactive function is provided to the display separate from the plurality of hand-held devices is configurable through the mobile hand-held device.

In an analogous art, Yen discloses a system wherein a user is provided the means to control whether information of interest to which the system is alerted is displayed on screen (col. 11, lines 56-65 and col. 13, lines 28-48), for the benefit of granting a user additional control over the features of the interactive system (col. 3, lines 5-35, wherein a user can explicitly activate and deactivate the foreground element).

It would have been obvious at the time to a person of ordinary skill in the art to modify the machine readable medium and apparatus of Wharton, Darbee, Goldstein, and Lappington to include means to control whether information of interest to which the system is alerted is displayed on the display, as taught by Yen, for the benefit of granting a user additional control over the features of the interactive system, as some users would be more interested in interactive features and thus would opt to have an onscreen display of such, and others lack interest in interactive features and would turn such alerts off.

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton, Darbee, Goldstein, and Lappington as applied to claim 17 above, and further in view of Stautner et al. (6,172,677, of record) [Stautner].

Regarding claim 27, Wharton, Darbee, Goldstein, and Lappington disclose the machine readable medium of claim 17, but fail to disclose one of the interactions received at the mobile hand-held device includes user comments.

In an analogous art, Stautner teaches it was known in the art to include chat sessions as an interactive feature associated with broadcast programming, allowing users to discuss amongst themselves and share ideas related to said programming (fig. 3, 'chat session').

It would have been obvious at the time to a person of ordinary skill in the art to modify the machine readable medium of Wharton, Darbee, Goldstein, and Lappington to include user comments, as taught by Stautner, for the benefit of allowing users to discuss amongst themselves and share ideas related to said programming.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOMINIC D. SALTARELLI whose telephone number is (571)272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/875,707
Art Unit: 2421

Page 14

/Dominic D Saltarelli/
Examiner, Art Unit 2421